

Appl. No.: 09/939,782
Amdt. Dated: August 29, 2005

REMARKS/ARGUMENTS

Applicants request entry of a one-word change to Claims 1, 21, 35, 36, and 37, on the ground that such amendment places the claims in better form for consideration on appeal. The amendment changes the phrase "one of the seller, the purchaser and the delivery service" by substituting "and" so that the phrase reads: --one of the seller, the purchaser or the delivery service.-- The applicants intended the phrase to be read to present alternatives rather than to require action by one of each of three entities, and submit that one skilled in the art, considering the specification, would interpret the phrase prior to amendment to cover action by any one of the three entities alone. However, following the decision in *Superguide v. DirectTV Enterprises, Inc. et al.*, Nos. 02-1561, -1562, -1594, 358 F.3d 870 (Fed. Cir. February 12, 2004), the requested amendment will clarify the meaning of the phrase and therefore place the claims in better form for consideration on appeal.¹

The phrase in question occurs in the context of providing instructions or a request related to shipment information, coordination of delivery, or a hold command. Embodiments described in the detailed description portion of the present application clearly contemplate that only one of the possible entities need provide the relevant instruction or request. For example (emphasis supplied):

Use of holding facilities in a country other than the second country may be in response to a customized requested submitted by the purchaser 17, or a customized hold request transmitted by the information system 13. Page 9, line 30 – page 10, line 1.

For instance, the information system may be capable of electronically receiving instructions from one of the seller, the purchaser or the delivery service system and may be further capable of electronically delivering notification information to the purchaser. The instructions contain shipping information on a package

¹ Under the decision in *Phillips v. AWH Corp., et al.*, Nos. 03-1269, -1286 (Fed. Cir., July 12, 2005) (en banc), the specification and other intrinsic evidence should be given more significance than an external grammatical treatise of the type relied on in *Superguide*.

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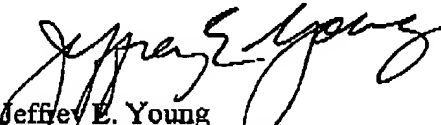
already shipped by the first local delivery system 20 and a request for coordination by the information system 13. Page 11, line 30 – page 12, line 3.

The request system 32 is capable of receiving instructions from the seller 16, purchaser 17 or the delivery service system 11. The instructions request coordination of the payment for, and delivery of, the package by the information system 13. The request system 32 is further capable of sending a coordination request verification to the hold system. Page 13, line 31 – page 14, line 4.

Furthermore, in connection with the embodiment associated with the flow chart of Figure 4, only the seller is described as entering shipment information. Page 14, lines 18-20. The specification describes no embodiment in which input from all three entities is required for initiating coordination of delivery or a hold command, or for providing shipment information. Therefore, one skilled in the art would have interpreted the phrase as stating the matter in the alternative. Entry of the amendments requested herein would prevent any issue from arising as to the meaning of the phrase amended. Therefore the applicants respectfully request entry of the amendments.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,

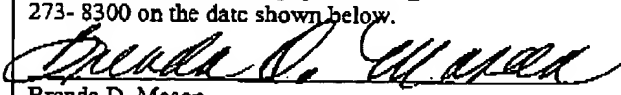

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